

REMARKS

No claims are amended or canceled, and claim 57 is added; as a result, claims 31-57 are now pending in this application.

Rejections of the Claims

Claims 31-41, 43, 44, 52 and 54 were rejected under 35 USC § 102(b) as being anticipated by Jackson et al. (U.S. 4,741,944). In the alternative, the Office Action rejects claims 31-41, 43, 44, 52 and 54 under 35 USC § 103(a) as being unpatentable over Jackson et al. Claims 55 and 56 were rejected under 35 USC § 103(a) as being unpatentable over Jackson et al. Claims 31-37, 40, 43-47 and 54-56 were rejected under 35 USC § 103(a) as being unpatentable over Wideman (U.S. 5,606,965) in view of Jackson et al. Claims 38, 39 and 48-53 were rejected under 35 USC § 103(a) as being unpatentable over Wideman in view of Jackson et al. and further in view of Buczwinski et al (U.S. 5,785, 179). Claim 42 was rejected under 35 USC § 103(a) as being unpatentable over Jackson et al. in view of Wright (U.S. 5,385,775). Claim 42 was rejected under 35 USC § 103(a) as being unpatentable over Wideman in view of Jackson et al. and further in view of Wright.

All of the above rejections are based at least in part on Jackson. Applicant respectfully submits that reliance on Jackson to reject the claims under either 35 U.S.C. §§ 102 or 103 is misplaced. Accordingly, the rejections must be withdrawn.

“Anticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). The Office Action admits that Jackson does not explicitly teach the features of the thickness after stretching would be greater than the thickness before stretching. Thus, a *prima facie* case of anticipation has not been made. Reconsideration and withdrawal of the anticipation rejection are requested.

The Office Action admits that Jackson does not teach all of the features of independent claims 31 and 36. But, the Office Action maintains that the increases thickness after stretching as recited in claims 31 and 36 is inherent in Jackson because Jackson uses similar materials and similar production steps used to produce a wet-wipe. Applicant respectfully disagrees because the Office Action has not established a *prima facie* case of inherency because, as recited in

MPEP § 2112, “In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Applicant submits that the thickness features recited in independent claims 31 and 36 are not necessarily inherent in Jackson. For example, Jackson may use meltblown fibers and spunbond fibers of sufficient thickness such that they do not collapse and require an increase in thickness after stretching. Accordingly, the increase in thickness after stretching does not necessarily flow from the teachings of Jackson. As a result, a prima facie case of anticipation or obviousness has not been made. Reconsideration and withdrawal of the obviousness rejection is requested.

Applicant further submits that Jackson teaches away from the present invention as defined by the pending claims. Specifically, Jackson teaches that the gathers of adjacent interleaved wipes are in general facing parallel alignment to each other so that the gathers of a leading wipe are adapted to temporarily engage the gathers of an immediately following wipe upon removal of the leading wipe. Col. 6, lines 3-16. If the gathers of Jackson were compressed to a reduced height, then the gathers would not necessarily engage the gathers of a following wipe during removal. Thus, Jackson’s gathers must maintain a minimum height and not be compressed and decompressed when dispensed. This teaches away from the presently claimed invention as recited in claims 31-41, 43, and 44.

Applicant further asserts that patentability of the present claims does not hinge on inherency but on whether Jackson teaches all of the features of the claims - anticipation -, or whether Jackson provides some suggestion to modify its disclosure to arrive at the features of the present invention - obviousness. The Office Action admits that Jackson does not teach all of the features of the present invention. No document applied against the claims in any rejection suggests the unexpected benefit of increasing the thickness of a wet-wipe before use.

The Office Action further states

Although Jackson et al. do not explicitly teach the limitations that the thickness after stretching would be greater than the thickness before stretching, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. an elastic nonwoven web and a gathered non-elastic nonwoven web) and in the similar productions steps (i.e. bonded so that the non-elastic web is gathered when in the composite is relaxed).

Applicant traverses these assertions. The “materials” and “production steps” (phrase as used in the Office Action) are not as similar as asserted in the Office Action. In an embodiment, the bonded non-elastic web includes natural fibers. Applicant can not find where Jackson teaches using a natural fiber. Accordingly, there is at least one embodiment not of the same materials and thus not made using the same production steps.

The Office Action relies on *In re Fitzgerald*, 205 USPQ 594, for support of its position. Applicant submits that reliance on this decision is misplaced. The Court of Customs and Patent Appeals, in *In re Fitzgerald*, stated

We note that in *Best* the relevant issue was whether a functionally claimed cooldown rate was inherently disclosed by a prior art reference--not unlike the instant case in which the claimed crystallization shrinkage is asserted by appellants to be exclusively a function of the cooldown rate of the crystallizable polymer. "[Where] the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." *In re Best*, supra at 1254-55, 195 USPQ at 433 (quoting from *In re Swinehart*, 58 CCPA 1027, 439 F.2d 210, 169 USPQ 226 (1971)).

Applicant respectfully submits that independent claims 31, 36 and 47 do not have functional limitations. Each limitation in claims 31, 36 and 47 are structural features. Accordingly, there is no functional test or functional process required to determine patentability that needs to be performed. Claim 31 recites, in part, the second thickness being greater than the first thickness. Claim 36 recites, in part, the second thickness being greater than the first thickness. Claim 47 recites, in part, during stretching, the natural fibers of the at least one gatherable layer break free from adjacent material to an increased thickness. Applicant can not find these structural features in Jackson. Accordingly, pending claims 31- 56 are allowable over Jackson.

Turning to the rejection of claims 31-41, 43, 44, 52, and 54 as obvious over Jackson, applicant traverses. The Office Action relies on *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as authority for the obviousness rejection. Applicant submits that a better authority for the present application is *In re Spormann*, 150 USPQ 449, wherein the CCPA found a claimed subject matter is not inherent in a prior art document where the prior art document makes no mention of the process and the process is not the applicant's process. Such is the case here. Jackson does not mention increased thickness in its wet-wipe. Jackson's process is not the same

process as the present process. Reconsideration and withdrawal of the obviousness rejection is requested.

With regard to claims 32 and 34, the Office Action states “it would likely be inherent that it would stretch between 5 and 30% its original length as it comes out of the container or during its every day use. This is not a legally acceptable basis for rejecting claims 32 and 34. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Office Action merely states that a certain thing may be likely and not be certain or recognized by persons of ordinary skill. Accordingly, claims 32 and 34 are allowable. Withdrawal of the rejection of claims 32 and 34 is requested.

With regard to claims 33, 35, and 54, applicant traverses. The Office Action merely states that the amount of thickness gain and density loss would be inherent or obviously provided for the same reasons as set forth above [in the Office Action]. Applicant traverses for the same reasons as set forth above. Moreover, applicant further asserts that such a rejection does not provide a *prima facie* case of anticipation or obviousness as the rejection lacks specificity needed to appeal any further rejection of these claims. Further, applicant submits that these claim 33, 35, and 54 are allowable as they recite features not found, discussed or even suggested in Jackson. Reconsideration and allowance of claims 33, 35, and 54 are requested.

With regard to claims 37, 40, 41, and 43, applicant traverses. The Office Action rejects claims 37, 40, 41 and 43 and being either inherent or as discovering an optimum value of a result effective variable. First, the features in claims 37, 40, 41, and 43 are not inherent for at least the reasons stated above. Second, the features of claims 37, 40, 41, and 43 are not merely optimum values, as these features must also allow the thickness of the wet-wipe to be increased from the first mode to the second mode.

With regard to claims 38 and 39, applicant respectfully traverses. Specifically, applicant can not find where Jackson suggests using preservatives, fragrances, humectants, detergents, and soaps in a wet-wipe that has a second thickness greater than the first thickness as recited in claims 38 and 39. Reconsideration and withdrawal of the rejection of claims 38 and 39 are requested.

With regard to claim 52, applicant respectfully traverses. Specifically, applicant can not find where Jackson suggests liquid in an amount of 150% to 600% of a dry weight of the composite elastic material in a wet-wipe that has a second thickness greater than the first thickness as recited in as recited in claim 52. Reconsideration and withdrawal of the rejection of claim 52 is requested.

With regard to claims 55 and 56, applicant respectfully traverses. The Office Action states that it would have been obvious to make a wet-wipe within the range of 1.0 mm to 1.7 mm and to make a wet-wipe in the container with a thickness of less than 0.9 mm since such a modification would have involved a mere change in size of a component. First, applicant traverses this single reference obviousness rejection as a form of Office Notice and requests a reference or affidavit from the examiner in compliance with the MPEP. Second, Jackson does not teach or suggest that the thickness is a mere change in size. Third, applicant can not find where Jackson teaches or suggests a wet-wipe that has a second thickness greater than a first thickness with either a second thickness within the range of 1.0 mm to 1.7 mm (claim 55) or a first thickness of less than 0.9 mm (claim 56). Reconsideration and withdrawal of the rejection of claims 55 and 56 are requested.

The Office Action further rejects claims 31-37, 40, 41, 43-47 and 54-56 as obvious over Wideman (U.S. Pat. No. 4,606,964) in view of Jackson. Applicant traverses. Jackson does not teach the feature of a multi-mode wet-wipe, a wet-wipe with a second thickness greater than the first thickness, or during stretching, the natural fibers of the at least one gatherable layer break free from adjacent material to an increased thickness. The Office Action further admits that Wideman does not teach the features of the thickness after stretching being greater than the thickness before stretching.

The Examiner has the burden under 35 U.S.C. 103 to establish a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a prima facie case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. Id. The M.P.E.P. contains explicit direction to the Examiner that agrees with the In re Fine court:

In order for the Examiner to establish a prima facie case of obviousness, three base criteria must be met. First, there must be

some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

The fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In *re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. 2143.01. That is, unless all three of the conditions described in M.P.E.P. 2142 are met, a prima facie case of obviousness is not established, and rejection under 35 U.S.C. 103 is improper. Applicant first asserts that all of the claims features are not taught or suggested by Wideman in view of Jackson. The Office Action admits that all of the features are not taught in Wideman. Applicant further asserts that there is no reasonable expectation of success to modify Wideman in view of Jackson. There is no reasonable expectation of success at least based on the fact that neither Widemann nor Jackson mention the features as recited in claims.

With respect to the dependent claims 42, applicant asserts that it is allowable along with its parent claim 36.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

DAVID J. BAER ET AL.

By their Representatives,

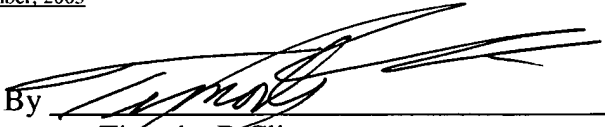
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16 Dec '03

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